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REMARKS

Claims 22, 25-31 and 34-44 are currently under considered in the subject application. Claims 22, 25, 26, 29, 38-40, 43, and 44 have been amended herein. Claim 31 has been canceled without prejudice due to being incorporated into the parent independent claim. No new matter has been added. New claims 46-49 have been added for consideration. Amendments to the claims can be found at pages 2-7.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 22, 26-30, 38, 39 and 43 Under 35 U.S.C. §102(b)

Claims 22, 26-30, 38, 39 and 43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shepard (US Patent 3,341,711). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Shepard does not teach or suggest the claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Shepard teaches a photoelectrically controlled lighting system. The system includes a prismatic apparatus for directing light to a photo-control unit.

In contrast, the subject invention is a data collection device that utilizes an image sensor. The Examiner suggests that "...an image sensor by definition is an electrical device which senses and/or responds to light...". Applicant's representative respectfully disagrees, in that the Examiner's definition is too broad in accordance with the definition of an image sensor as generally understood in the art. An image is a picture or representation of an object or scene on paper or a display screen. An image sensor contains many pixels arranged in a matrix that sense light of the image. The image sensor is a solid-state device that contains a photo site for each pixel in the image. Each photo site records the brightness of the light that strikes it during an exposure to the image. Shepard does not teach an image sensor.

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Moreover, as recited in amended claims 22, the image sensor is one “...that senses a bar code...” Furthermore, the image sensor “...generates a pixel data pattern...”

As recited in amended claims 38, the image sensor is one that “...converts the scanned dataform into a pixel data pattern...”

As recited in claims 26, the image sensor “...converts the dataform into a pixel-by-pixel representation...”, and in amended claim 43, “...converts the light into a pixel-by-pixel representation...”.

Shepard does not teach such capabilities. Furthermore, the subject claims are drawn to a data collection device scan engine and assembly thereof, which Shepard neither teaches nor suggests. Thus, this rejection should be withdrawn for these independent claims and the claims that depend therefrom.

II. Rejection of Claims 22, 26-31, 36, 38, 39 and 43 Under 35 U.S.C. §102(b)

Claims 22, 26-31, 36, 38, 39 and 43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ogura *et al.* (US Patent 5,825,560). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Ogura *et al.* does not teach each and every element of the subject claims.

Ogura *et al.* teaches, in one embodiment, an optical apparatus that uses a plurality of prism-like optical members that direct light to an image sensing element (see Figure 1).

In another embodiment, Ogura *et al.* teaches an optical apparatus the uses a plurality of lens groups aligned and movable along an optical axis to facilitate a zoom mechanism to adjust light to the image sensing element (see Figure 23).

As recited in amended claim 22, the image sensor is one “...that senses a bar code...” Ogura *et al.* does not teach sensing a bar code.

As recited in amended claims 22, 26, 38, and 43, the “...light enters a first surface of the lens without impacting an intermediate lens, and exits the lens directly to the prism.” Ogura *et al.* does not teach such a lens arrangement.

In view of at least the above comments, it is respectfully submitted that Ogura *et al.* does not anticipate or render obvious applicant's invention as recited in claims 22, 26-31, 36, 38, 39, and 43, and withdrawal of this rejection is requested.

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III. Rejection of Claims 25, 34, 35, 37, 40-42, and 44 Under 35 U.S.C. §103(a)

Claims 25, 34, 35, 37, 40-42, and 44 stand rejected under 35 U.S.C. §103(a) as being obvious over Ogura *et al.* This rejection should be withdrawn for at least the following reasons. Ogura *et al.* neither teaches nor suggests the limitations in the recited independent claims 22, 26, 38 and 43.

In Figure 1, Ogura *et al.* teaches an optical apparatus that uses a plurality of prism-like optical members that direct light to an image sensing element. In Figure 23, Ogura *et al.* teaches an optical apparatus the uses a plurality of lens groups aligned and movable along an optical axis to facilitate a zoom mechanism to adjust light to the image sensing element.

As recited in amended claims 22, 26, 38 and 43, the subject invention includes a lens arrangement such that "the light enters a first surface of the lens without impacting an intermediate lens, and exits the lens unimpeded to the prism."

Nowhere does Ogura *et al.* teach or suggest the use of a lens arrangement as recited in the amended claims. Moreover, modifying the system of Ogura *et al.* would render it unsatisfactory for the subject invention. Thus, one of ordinary skill in the art would not have been motivated by its teachings to modify it as suggested in Office Action. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (holding there is no suggestion or motivation to modify the prior art if such modification would render the prior art invention unsatisfactory for its intended purpose).

With respect to claims 34, 35, 41, and 42, nowhere does Ogura *et al.* teach or suggest the use of a printed circuit board. In fact, Ogura *et al.* teaches away from use of a printed circuit board by requiring a rigidity that is not normally associated with a printed circuit board. Ogura *et al.* teaches the use of a board (1) that needs to support heavy materials. For example, with respect to Figure 1, Ogura *et al.* teaches that the board supports optical, as well as mechanical systems (Col. 5, lines 48-50), to include numerous prism-like optical members; and permanent magnets, a coil, and a yoke (that constitutes a rotating actuator system) (Col. 6, lines 32-38). Some of the optical members are movable on an upper surface of the board using a moving base that is made of iron. With respect to the optical apparatus of Figures 15 and 16, Ogura *et al.* teaches that the board is made of a ceramic material, with iron and aluminum boards mounted on the main board for "excellent dimensional stability" (col. 16, lines 1-19). Thus, it would not have been obvious to use a printed circuit board in view of the cited reference.

For at least these reasons, applicant's representative requests that the rejection for these

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claims be withdrawn.

IV. Rejection of Claims 22 and 43 Under 35 U.S.C. §103(a)

Claims 22 and 43 stand rejected under 35 U.S.C. §103(a) as being obvious over Taniguchi *et al.* (US Patent 5,852,287). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Taniguchi *et al.* does not teach or suggest the claimed invention.

As recited in amended claims 22 and 43, Taniguchi *et al.* neither teaches or suggests “an image sensor that includes an aperture.” Moreover Taniguchi *et al.* fails to teach or suggest “a prism mounted on the aperture”. Additionally, Taniguchi *et al.* fails to teach or suggest that “...light enters a first surface of the lens without impacting an intermediate lens, and exits the lens directly to the prism.” Furthermore, there is no motivation to modify the system of Taniguchi *et al.* to do so, since that would render it unsatisfactory for its intended purpose.

The prism of the subject invention directs light from a *first path* entering the prism to a *second path* and into an aperture of the image sensor. At least such aspects of applicant's invention as recited in independent claims 22 and 43 are not disclosed or suggested by Taniguchi *et al.* Rather, at Figure 1, Taniguchi *et al.* illustrates a light beam 17 that travels through the prism 22 onto a photodiode 15 along the *same straight path*, with no redirection from a first path to a second path, as in applicant's claimed invention.

In view of at least the above comments, it is respectfully submitted that Taniguchi *et al.* does not anticipate or render obvious applicant's invention as recited in claims 22 and 43. Thus, withdrawal of this rejection is requested for these claims, and the claims that depend therefrom.

VI. Rejection of Claims 26, 27, and 36-38 Under 35 U.S.C. § 103(a)

Claims 26, 27, and 36-38 stand rejected under 35 U.S.C. § 103(a) as being obvious over Taniguchi *et al.* as applied to claim 22 and 43 above, and further in view of Taniguchi (US Patent 5,719,389). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Taniguchi ('389) does not make up for the aforementioned deficiencies of Taniguchi *et al.* with respect to applicant's claimed invention. Accordingly, the combination of Taniguchi ('389) and Taniguchi *et al.* does not render obvious applicant's invention as recited in

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independent claim 26, claims 27, 36, 37 that depend therefrom, and independent claim 38.
Withdrawal of this rejection is respectfully requested.

09/668.105T139CONCLUSION

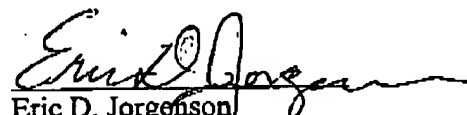
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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